



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,483	05/01/2001	Laurent Chambard	2000M005	7731

7590

05/20/2005

Infineum USA L.P.  
Law Department  
1900 East Linden Avenue  
P.O. Box 710  
Linden, NJ 07036-0710

EXAMINER

MCAVOY, ELLEN M

ART UNIT

PAPER NUMBER

1764

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/846,483

Applicant(s)

CHAMBARD ET AL.

Examiner

Ellen M. McAvoy

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicants' submission filed on 28 February 2005 has been entered.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. THIS IS A NEW MATTER REJECTION. It is not clear where in the specification there is literal support for supplying to the engine crankcase the trunk piston engine oil lubricating composition to which independent claims 10 and 17 are now drawn. In the remarks

Art Unit: 1764

filed 28 February 2005, applicants have not pointed out where in the specification there is support for the claimed amendments.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clarke (4,283,294) and Fujitsu et al (6,114,288), considered separately.

As previously set forth, Clarke discloses lubricating oil compositions suitable for use in marine diesel engines comprising 60 to 85 parts by weight of lubricating oil, 15 to 30 parts by weight of a mixture of more than 50 weight % of a Group IIa metal overbased detergent and up to 50 weight % of a Group Ia metal overbased detergent and 0.2 to 5 parts by weight of an antioxidant, provided the molecular weight ratio of the overbased detergent mixture to antioxidant lies between 7.5:1 and 50:1. The lubricating oil may be an animal, vegetable, mineral oil or synthetic oil and is preferably a hydrocarbon oil such as mineral oil. See col. 1, lines 17-44. Suitable overbased detergent additives include phenates, sulphonates, and salicylates. See column 1, line 67 to column 2. See especially lines 43-55 of column 2 where overbased calcium salicylate is taught. Examples of suitable antioxidants include alkylated phenols, organic amines, organic sulphur compounds and metal thiophosphates. See column 3,

Art Unit: 1764

lines 52-54. Zinc dialkyldithiophosphate is taught as suitable. See column 4, lines 3-6. Clarke teaches that to be suitable for use in the lubricating oil composition of this invention, the overbased detergent should have a TBN of between 175 and 500. See column 3, lines 29-32.

The examiner maintains the position that the oil compositions of Clarke meet the limitations of the composition of the method claims when the detergent component is an overbased salicylate.

The examiner is of the position that applicants' method claims of lubricating a four-stroke medium speed compression-ignited (diesel) marine engine which comprises supplying the claimed oil composition to the engine crankcase are still encompassed by the disclosure of Clarke.

Applicants argue that the Board of Appeals in the decision of 24 November 2004, agreed that the application was unpatentable over the Clarke patent based, *inter alia*, on the assertion that the claims did not require that the defined lubricating oil composition be added to the crankcase of the marine diesel engine. Applicants argue that, as noted previously, the Clarke patent is directed to marine diesel cylinder lubricants (MDCL) which, in two-stroke engines, are added to a diesel fuel and burned together with the fuel in operation of the engine. As set forth in column 1, lines 12-16, Clarke teaches an oil composition which when used in loop-scavenged crosshead marine diesel engines assists considerably in reducing fouling of the air ports with deposits and which also displays satisfactory antiwear performance. The examiner is of the position that even with the amendments to the claims, the marine diesel engine oil composition of Clarke still meets the limitations of method claims 10-23 for the reasons set forth and since

the Board stated that “the appellants have not identified any evidence to indicate that Clarke’s lubricating oil composition cannot be used as a TPEO” (trunk piston engine oil).

As also previously set forth, Fujitsu et al [“Fujitsu”] disclose lubricating oil compositions for internal combustion engines comprising a base lubricating oil, (1) a zinc dithiophosphate and (2) a metallic detergent chosen from calcium alkylsalicylate and a mixture of calcium alkylsalicylate and magnesium alkylsalicylate and, optionally, (3) a friction modifier. The examples set forth in Table 2 comprise compositions with metallic detergent A, a calcium salicylate having a TBN of 150 mg KOH/g; metallic detergent B, a calcium salicylate having a TBN of 80 mg KOH/g; and metallic detergent C, a magnesium salicylate having a TBN of 340 KOH/g. See examples 1 and 2 which also comprise wear resistance agent A which is a secondary zinc dithiophosphate. The examiner maintains the position that these examples meet the limitations of the composition claims which comprise three components: (A) an oil of lubricating viscosity, (B) an oil-soluble overbased metal detergent additive consisting of one or more aromatic carboxylates, and (C) an antiwear additive. Applicants’ open-ended claim language “comprising” allows for the addition of other components to the composition such as the friction modifier component of Fujitsu. Although marine diesel engines are not taught in Fujitsu, the oil compositions are taught as suitable for use as an engine oil for internal combustion engines wherein the oil exhibits excellent anti-wear properties with respect to moving valve parts in four-stroke engines (lines 5-9, column 1) and the medium-speed four-stroke marine diesel engines of the claims are an example of such an internal combustion engine.

Applicants argue that the relatively low TBN of the exemplified lubricants, the industry tests described, the use of organic friction modifiers and other factors make it clear that those skilled in the art that Fujitsu is directed to crankcase lubricants for passenger car engines, as opposed to marine diesel engines. This is not deemed to be persuasive of the patentability of the claims at issue because the disclosure of Fujitsu is not limited to the exemplified examples and, as stated by the Board, “the appellants fail to identify any evidence in support of the theory that Fujitsu’s lubricating oil composition cannot be used for the same purpose disclosed in the present specification”.

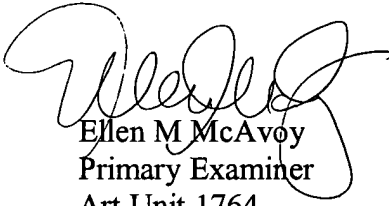
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 1764

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ellen M McAvoy  
Primary Examiner  
Art Unit 1764

EMcAvoy  
May 17, 2005